REMARKS/ARGUMENTS

Reconsideration and continued examination of the above-identified application are respectfully requested.

Rejection of claims 1 - 39 under 35 U.S.C. §103(a) over Hansson et al. in view of Casto.

At page 2 of the Office Action, the Examiner rejected claims 1 - 39 under 35 U.S.C. §103(a) as being unpatentable over Hansson et al. (U.S. Patent No. 6,465,046 B1), in view of Casto (U.S. Patent No. 1,947,459). The Examiner alleged that Hansson et al. teaches the formation of a floor covering by optionally coating a core of wood or other material with an acrylic layer, then printing a digital pattern on the layer, then coating a wear coating, which may be a multi-layer structure and contain nano-particles to enhance wear, followed by embossing of the layers in registration with the printing. The Examiner further alleged that Casto teaches forming a wood grain pattern on a surfacing material by embossing the core first and then putting pigment into the embossed areas in order to create a realistic design. The Examiner further alleged that the core may be coated and the coating embossed and the embossments filled with pigment to get multicolor effects. The Examiner noted that the instant invention claims embossing a core, or a coating layer on a core with a design, and then printing in registration with the design by a digital printer with a high resolution. The Examiner took the position that it would have been obvious to have formed embossments in the core or coating layers of Hansson et al. and then to have printed in registration with digital means in order to make a better simulation of wood grain and other natural patterns because of the teachings of Casto. For the following reasons, this rejection is respectfully traversed.

It is respectfully submitted that the claims of the present invention differ from the

teachings of the cited references in that Hansson et al. shows printing onto a surface, then applying a lacquer coating and then embossing the lacquered surface. In other words, Hansson et al. only shows printing, coating, and then embossing. Hansson et al. does not teach or suggest a surface covering in which a surface is first textured and then printed with a printed pattern in registration with the textured surface as required by independent claim 1 of the present application. Casto does not supply this missing feature. In Casto, a plaster or asbestos board is subjected to pressing to form interstices in the face of the board, then the entire surface is coated with a pigment, and then surplus pigment is scraped off so that pigment remains only in the interstices of the board. The Examiner is in error in interpreting the process of Casto as being printing in registration with a textured surface, and the Examiner has not provided any reasoning or justification for his conclusion that the present invention would be obvious over the combined references. The Examiner simply described the coating process of Casto, which is clearly different from printing in registration with a textured surface, and stated that it would have been obvious to modify Hansson et al. to form embossments in a core and then print in registration "because of the teachings of Casto." Contrary to what is alleged by the Examiner, the combination of the references does not teach or suggest the claimed invention and there is nothing in Casto that would teach or motivate a person skilled in the art to modify Hansson et al. to form embossments in a core and then print in registration. Thus, Hansson et al. in view of Casto does not teach or suggest the subject matter of claims 1 - 39. Accordingly, the rejection under 35 U.S.C. §103(a) should be withdrawn.

Rejection of claims 1 - 39 under the judicially created doctrine of obviousness-type double patenting over claims 1 - 39 of U.S. Patent No. 6,617,009 in view of Hansson et al. and Casto

At page 4 of the Office Action, the Examiner rejected claims 1 - 39 under the judicially created doctrine of obviousness-type double patenting over claims 1 - 39 of U.S. Patent No. 6,617,009 ("the '009 patent") in view of Hansson et al. and Casto. The Examiner alleged that the '009 patent claims a print layer with a cover layer on a core, and that the secondary references teach embossing and digital printing of a wood grain layer to have a better simulation. The Examiner took the position that the instant claims would have been obvious in view of the claims of the '009 patent as modified by the secondary references in order to provide a better simulation. For the following reasons, this rejection is respectfully traversed.

Modifying the '009 patent to add the features described in Hansson et al. and Casto would not result in the present invention, for the reasons discussed above regarding the Hansson et al. and Casto references taken alone. The only thing that the '009 patent adds to the above discussion is that it discloses a print layer affixed to the top surface of a core. The claims of the '009 patent mention nothing about a surface covering in which a surface is first textured and then printed with a printed pattern in registration with the textured surface.

Thus, claims 1 - 39 of U.S. Patent No. 6,617,009 in view of Hansson et al. and Casto do not teach or suggest the subject matter of claims 1 - 39. Accordingly, the rejection under the judicially created doctrine of obviousness-type double patenting should be withdrawn.

Provisional rejection of claims 1 - 39 under the judicially created doctrine of obviousness-type double patenting over claims 7 - 21, 31 - 33, 37 - 40 and 42 - 54 of copending Application No. 09/630,121 in view of Hansson et al. and Casto

At page 4 of the Office Action, the Examiner provisionally rejects claims 1 - 39 under the judicially created doctrine of obviousness-type double patenting over claims 7 - 21, 31 - 33, 37 - 40, and 42 - 54 of copending Application No. 09/630,121 in view of Hansson et al. and Casto. The Examiner alleged that the '121 application claims printing on a core with a cover layer and that the secondary references teach embossing and digital printing of a wood grain layer to have a better simulation. The Examiner took the position that the instant claims would have been obvious in view of the '121 claims as modified by the secondary references in order to provide a better simulation. For the following reasons, this rejection is respectfully traversed.

The combination of Hansson et al. and Casto with the claims of the cited '121 application does not result in the present invention. Independent claims 31 and 47 of the '121 application recite a digital printed design on a top surface of a thermoplastic core and a protective layer affixed to the top surface of the digital printed design, but none of claims 7 - 21, 31 - 33, 37 - 40, and 42 - 54 mention anything about a surface covering in which a surface is first textured and then printed with a printed pattern in registration with the textured surface. As discussed above, Hansson et al. and Casto in combination do not teach this feature. Accordingly, Hansson et al. and Casto, taken as secondary references, do not overcome the failure of the cited '121 application to teach or suggest a surface covering in which a surface is first textured and then printed with a printed pattern in registration with the textured surface.

Thus, claims 7 - 21, 31 - 33, 37 - 40, and 42 - 54 of copending Application No. 09/630,121 in view of Hansson et al. and Casto do not teach or suggest the subject matter of

claims 1 - 39. Accordingly, the provisional rejection under the judicially created doctrine of obviousness-type double patenting should be withdrawn.

Provisional rejection of claims 1 - 39 under the judicially created doctrine of obviousness-type double patenting over claims 45 - 73 of copending Application No. 10/909,684 in view of Hansson et al. and Casto

At page 5 of the Office Action, the Examiner provisionally rejects claims 1 - 39 under the judicially created doctrine of obviousness-type double patenting over claims 45 - 73 of copending Application No. 10/909,684 in view of Hansson et al. and Casto. The Examiner alleged that the '684 application claims a print layer on a core with a cover layer and that the secondary references teach embossing and digital printing of a wood grain layer to have a better simulation. The Examiner took the position that the instant claims would have been obvious in view of the '684 claims as modified by the secondary references in order to provide a better simulation. For the following reasons, this rejection is respectfully traversed.

The combination of Hansson et al. and Casto with the claims of the cited application does not result in the present invention. Independent claim 45 of the '684 application recites a print layer on a top surface of a thermoplastic core and a protective layer affixed to the top surface of the print layer, but none of claims 45 - 73 mention anything about a surface covering in which a surface is first textured and then printed with a printed pattern in registration with the textured surface. As discussed above, Hansson et al. and Casto in combination also do not teach this feature. Accordingly, the Hansson et al and Casto, taken as secondary references, do not overcome the failure of the cited '684 application to teach a surface covering in which a surface is first textured and then printed with a printed pattern in registration with the textured surface.

Thus, claims 45 - 73 of copending Application No. 10/909,684 in view of Hansson et al. and Casto do not teach or suggest the subject matter of claims 1 - 39. Accordingly, the provisional rejection under the judicially created doctrine of obviousness-type double patenting should be withdrawn.

Rejection of claims 1 - 39 under 35 U.S.C. §103(a) over Chen et al. in view of Hansson et al. and Casto

At page 6 of the Office Action, the Examiner rejected claims 1 - 39 under 35 U.S.C. §103(a) over Chen et al. (U.S. Patent No. 6,617,009 B1 (the same reference as "the '009 patent" discussed above)) in view of Hansson et al. and Casto. The Examiner alleged that the Chen et al. claims a print layer with a cover layer on a core, and that the secondary references teach embossing and digital printing of a wood grain layer to have a better simulation. The Examiner took the position that it would have been obvious to have embossed and then digitally printed the layer of Chen et al. in order to provide a better simulation. For the following reasons, this rejection is respectfully traversed.

As discussed above, modifying Chen et al. to add the features described in Hansson et al. and Casto would not result in the present invention. Chen et al. discloses a print layer affixed to the top surface of a core but contains no mention about a surface covering in which a surface is first textured and then printed with a printed pattern in registration with the textured surface.

Thus, Chen et al. in view of Hansson et al. and Casto does not teach or suggest the subject matter of claims 1 - 39. Accordingly, the rejection under 35 U.S.C. §103(a) should be withdrawn.

Moreover, under the provisions of 35 U.S.C. §103(c), a rejection based on 35 U.S.C.

§102(e) may be overcome if it is shown that the application and the applied reference were commonly owned at the time the invention claimed in the application was made. In view of this provision, Applicants provide the following Statement of Common Ownership:

STATEMENT OF COMMON OWNERSHIP

The present application, Application No. 10/697,532 and U.S. Patent No. 6,617,009 were, at the time the invention of Application No. 10/697,532 was made, owned by Mannington Mills, Inc.

Accordingly, for this additional reason, the rejection under 35 U.S.C. §103(a) should be withdrawn.

CONCLUSION

In view of the foregoing remarks, the applicants respectfully request the reconsideration of this application and the timely allowance of the pending claims.

If there are any other fees due in connection with the filing of this response, please charge the fees to Deposit Account No. 50-0925. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such extension is requested and should also be charged to said Deposit Account.

Respectfully submitted,

Luke A. Kilyk
Reg. No. 33,251

Atty. Docket No. 3620-064-01
KILYK & BOWERSOX, P.L.L.C.
53 A East Lee Street
Warrenton, VA 20186
Tel.: (540) 428-1701
Fax: (540) 428-1720